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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/423,274 01/27/00 PUTTKAMMER F 990348

MM92/0216
LAW OFFICES OF KARL HORMANN
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CAMBRIDGE MA 02138-2216

EXAMINER

HAMDAN, W

ART UNIT	PAPER NUMBER
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2858

DATE MAILED: 02/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/423,274

Applicant(s)
Frank Puttkammer

Examiner
Wasseem H. Hamdan

Group Art Unit
2858



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-16 _____ is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-16 _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

Glenn W. Brown
Primary Examiner

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Part III - DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation in claims 1-16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

For example regarding claim 1, drawings do not show the limitation “the method for the testing of documents using the capacitive coupling between transmitter and receiver and the transfer of energy between transmitter and receiver by electrically conductive safety materials wherein for the forge test of documents with diffraction-optically effective safety layers with a discontinuous metallization layer or partially metallic layers or zones of metallic layers in different planes the electrical conductivity is determined and evaluated”. Correction is required.

Abstract

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Specification

3. The specification is not in the proper format, please see below how the is the requirements for content of the specifications below:

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Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a). The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Reference to a "Microfiche Appendix": See 37CFR 1.96(c) and MPEP § 608.05. The total number of microfiche and the total number frames should be specified.
- (e) Background of the Invention: The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

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- (g) Brief Description of the Several Views of the Drawing(s): A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
 - (h) Detailed Description of the Invention: A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. This item may also be titled "Best Mode for Carrying Out the Invention." Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
 - (I) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet. (37 CFR 1.52(b)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps.
 - (j) Abstract of the Disclosure: A brief narrative of the disclosure as a whole in a single paragraph of 250 words or less on a separate sheet following the claims.
 - (k) Drawings: See 37 CFR 1.81, 1.83-1.85, and MPEP § 608.02.
 - (l) Sequence Listing: See 37 CFR 1.821-1.825.
4. Specifications is not clear, and does not explain the invention in details.
5. On page 2: line 3, the specification can't refer to the claims for explanation, specification must stand alone in terms of explaining the invention.
6. The lines of the specifications and claims must be numbered.

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Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 14 which recites the limitations “using the capacitive coupling between transmitter and receiver and the transfer of energy” is indefinite as the scope of the claimed different kinds is unclear and not specific.

Regarding claim 1, it is not clear what are the steps that being claimed in the invention.

Regarding claims 1, 2, 4, 5, 6 and 14, element 14, 12 and 20 are different from what mentioned in the specification page 5: lines 2, 5 and 10.

Regarding claim 13 which recites the limitations “... including the testing of holograms in manual units” is indefinite as the scope of the claimed different kinds is unclear and not specific.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-8 and 12-13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber (US Patent 4,255,652) in view of Berger et al. (US Patent 6,165,592).

Regarding claim 1, Weber discloses the use of the method for the testing of documents [FIG. 2; FIG. 3; column 2: lines 66-67; column 3: lines 1-10] using the capacitive coupling [FIG. 2 (2A, 2B, and 2C); column 3: lines 11-27] between transmitter and receiver and the transfer of energy between transmitter and receiver by electrically conductive safety materials [column 3: lines 28-36] wherein

Regarding claims 1-6, 14 and 15, Weber discloses the essential elements of the claimed invention. However, Weber does not explicitly disclose for the forge test of documents with diffraction-optically effective safety layers with a discontinuous metallization layer or partially metallic layers or zones of metallic layers in different planes the electrical conductivity is determined and evaluated. Berger et al. disclose for the forge test of documents with diffraction-optically effective safety layers with a discontinuous metallization layer or partially metallic layers or zones of metallic layers in different planes the electrical conductivity is determined and evaluated [FIG. 2; FIG. 3; column 3: lines 36-45; column 5: lines 27-40]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Weber by including for the forge test of documents with diffraction-optically effective safety layers with a discontinuous metallization layer or partially

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metallic layers or zones of metallic layers in different planes the electrical conductivity is determined and evaluated. The skilled artisan would have been motivated to modify Weber as above for the purpose of obtaining an accurate and high speed method to match the document.

Regarding claim 14, Weber discloses energy is capacitively transferred from one or several transmitting electrodes to one or several receiving electrodes via metallization layers, the signals available at the receiving electrode or electrodes are amplified by means of an electronic evaluation system and are compared with a reference signal -and a signal classifying the document is available for further processing at the output of the electronic evaluation system [FIG. 2; FIG. 3; FIG. 4; column 3: lines 11-45].

Regarding claims 7-10, Weber discloses the essential elements of the claimed invention. However, Weber does not explicitly disclose including the testing of the fluorescent, phosphorescent, light-absorbing, magnetic properties of the additionally applicable authenticity feature. Berger et al. disclose including the testing of the fluorescent, phosphorescent, light-absorbing, magnetic properties of the additionally applicable authenticity feature [FIG. 2; FIG. 3; column 3: lines 17-59]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Weber by including the testing of the fluorescent, phosphorescent, light-absorbing, magnetic properties of the additionally applicable authenticity feature. The skilled artisan would have been motivated to

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modify Weber as above for the purpose of obtaining security check to the document [Berger et al. Column 3: lines 54-59].

Regarding claim 12, Weber discloses the essential elements of the claimed invention. However, Weber does not explicitly disclose including the testing of holograms in high-speed processing machines with a speed of up to 2000 documents per minute. Berger et al. disclose including the testing of holograms in high-speed processing machines with a speed of up to 2000 documents per minute [FIG. 2; FIG. 3; FIG. 4; column 2: lines 39-52]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Weber by including the testing of holograms in high-speed processing machines with a speed of up to 2000 documents per minute. The skilled artisan would have been motivated to modify Weber as above for the purpose of obtaining an accurate and high speed method to match the document. Even though Berger et al. do not specifically disclose 2000 documents per minute, but Berger et al. disclose high speed range 10m/sec which is obvious that Berger et al. design can be derived to obtain 2000 documents per minute. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418,420 (CCPA 1970). Applicant may consider overcoming the above assertion of obviousness by demonstrating that provision of the above design achieves unexpected results relative to the prior art. *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

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Regarding claim 13, Weber and Berger et al. disclose the essential elements of the claimed invention. However, Weber and Berger et al. do not explicitly disclose including the testing of holograms in manual units. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Weber and Berger et al. by including the testing of holograms in manual units. The skilled artisan would have been motivated to modify Weber and Berger et al. as above for the purpose of obtaining a flexible system. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418,420 (CCPA 1970). Applicant may consider overcoming the above assertion of obviousness by demonstrating that provision of the above design achieves unexpected results relative to the prior art. *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

Regarding claim 14, Weber discloses the electronic evaluation system the classifying signal is logically combined with an authenticity signal of an additionally applicable authenticity feature after it has been tested by means of another sensor and a combination signal classifying the document is available at the output of the electronic evaluation system for further processing [FIG. 2; FIG. 3; FIG. 4; column 3: lines 11-45].

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Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wasseem Hamdan whose telephone number is (703) 305-3968. The examiner can normally be reached Monday-Thursday from 700AM-400PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Safet Metjahic can be reached on (703) 308-1436.

The fax phone number for this Art Unit is (703)305-3432 or (703)305-3431.

Any inquiry of a general nature or relating to the status of this application should be directed to the Receptionist at (703) 305-3800.

12. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry, please label

"FORMAL" and sign as attorney of record)

Or:

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(703) 305-9724 (for informal or draft communications, please label

"PROPOSED" or "DRAFT" and prominently label PLEASE DELIVER

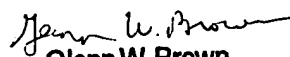
DIRECTLY TO EXAMINER)

Hand-delivered responses should be brought to Crystal Plaza 4 [fourth Floor
(Receptionist)], 2201 South Clark Place, Arlington, VA. 22202.

Wasseem H. Hamdan

WH

February 13, 2001


Glenn W. Brown
Primary Examiner